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| 10/603,530 | 06/25/2003 | Sophie Wastiaux | Serie 6126 | 2185 |
| 7590 Linda K. Russell Air Liquide 2700 Post Oak Blvd., Suite 1800 Houston, TX 77056 | | | EXAMINER WARTALOWICZ, PAUL A | |
| | | | ART UNIT 1793 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,530

Applicant(s)

WASTIAUX ET AL.

Examiner

PAUL A. WARTALOWICZ

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-40 is/are pending in the application.
- 4a) Of the above claim(s) 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 39 and 40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims (I) 32-38 and (II) 39 and 40 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make another and materially different product such as one without a fluid path and the outer surface of each tubular having a reduced diameter portion.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39 and 40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 32-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation in claim 32, lines 7-11 of "connecting the joining tubular...whereby the uninterrupted surface finish remains in the interior surface of the junction" does not appear to be supported in the specification. Applicant is requested to point out support in the specification.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bland et al. (2895747).

With respect to claims 32-36, Bland et al. teaches different embodiments which anticipate the claims.

In first embodiment, Bland teaches (see Figures 1-3), a method of protecting pieces of equipment (11 and 18) where the pieces have been protectively coated (14) and are joined to each other by welding (21) of the pieces together with a joining piece (12) which also has the protective coating (14) thereon. More specifically, Bland et al. teaches that after coating the member 11 and joining piece 12 (Column 2, lines 24-26) weld 21 is made joining members 11, 18, and 12 integrally (Column 2, lines 49-52). The equipment pieces and joining pieces are all steel, and the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly).

In a second embodiment, Bland teaches (see Figure 4) a method of protecting pieces of equipment (32, 37) where the pieces have been protectively coated (38, 34) and are joined to each other by welding (41) of the pieces together with joining pieces (39, 31) which also have the protective coating (34) thereon. More specifically, Bland et al. teaches that the pipe 32 and ring 31 are coated with aluminum (Column 3, lines 44-45) and after that pipe 37 is placed in position and a weld (41) is made to join pipes 32

and 37 and to weld ring 33 to the pipes (Column 3, lines 58-60). The equipment pieces and joining pieces are all steel, and the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly).

Regardless of which embodiment is relied upon, further limitations including fluids to be used in the equipment made, use in high temperature processes and the process in which the equipment made may be used merely recite intended use as claimed; nonetheless it would appear the method of Bland et al. would provide equipment capable of performing these intended uses as claimed since Bland et al. teaches that the equipment is known to have widespread use "in chemical reactors and the like and particularly in reactors associated equipment which are alternately exposed to reducing and oxidizing atmospheres" (column 1, lines 22-25).

With respect to portion "a" of claim 37, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding, the limitation of "such that the welding is not applied to inner surfaces of said pieces of equipment", "welding the treated joining piece to exterior faces of the pieces of equipment", "the regions of the treated pieces of equipment affected by

welding are not protected by the first or second protective coating"; the prior art is regarded as teaching this limitation in both embodiments. Further, upon cancellation of the new matter limitations, the prior art rejections are still retained as above.

With respect to the recitation in claim 32 of the uninterrupted surface finish, it is unclear whether the term "uninterrupted" refers to the coating being uninterrupted or whether there is an absence of welding on the interior surface. For the purposes of examination, this recitation is interpreted as the coating being uninterrupted.

Claims 32-34 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 824717.

GB 824717 teaches the process of producing corrosion-resistant equipment, specifically metal hollow bodies to be welded (page 1, lines 56-70) and refers specifically to carbon steel, iron pipe (page 1 lines 34 and 50), and further specifically defines the components of the figures as being carbon steel and corrosion resistant steel (page 2, lines 99-106). Also taught is (see Figure 2 or 3) that the components are connected by butt-welding (2) sleeves 3a and 3b together which sleeves are butt-welded (4) to components 1a and 1b and further that components 1a and 1b are protectively coated (5) and that the protective coating (5) covers at least a portion of the joining pieces (sleeves 3a and 3b); in Figure 2 the protective coating (5) is shown to partially cover sleeves 3a and 3b though the overlapping portion has no reference number while in Figure 3 the protective coating (5) is shown to partially cover sleeves 3a and 3b as shown by reference number 4a.

Further limitations including fluids to be used in the equipment made, use in high temperature processes and the process in which the equipment made may be used merely recite intended use as claimed; nonetheless it would appear the method of GB 824717 would provide equipment capable of performing these intended uses as claimed since GB 824717 teaches that the equipment is known to be produce "hollow metal bodies, such as containers, apparatus, or pipelines for corrosive liquid or solid substances, gases, or vapours, mixtures, or suspensions" (page 1, lines 56-60).

With respect to portion "a" of claim 37, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding, the limitation of "such that the welding is not applied to inner surfaces of said pieces of equipment", "welding the treated joining piece to exterior faces of the pieces of equipment", "the regions of the treated pieces of equipment affected by welding are not protected by the first or second protective coating"; the prior art is regarded as teaching this limitation in both embodiments. Further, upon cancellation of the new matter limitations, the prior art rejections are recited as above.

Claims 35, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 824717 in view of Bland et al. (2895747).

GB 824717 teach the method as explained above.

GB 824717 fail to teach aluminazation.

Bland teaches that the equipment pieces and joining pieces are all steel, and the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly) in GB 824717 in order to protect pipes exposed to similar high temperature and corrosive uses as taught by Bland et al.

Response to Arguments

Applicant's arguments filed 8/8/06 have been fully considered but they are not persuasive.

Applicant argues that neither Bland nor GB 824717 teach that inner surfaces have uninterrupted finish.

However, it appears that Bland has an uninterrupted finish because the coating is applied after the weld such that the finish is uninterrupted and continuous on the interior of the pipe.

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Additionally, it appears that there is no weld is on the interior surface of GB 824717 in the same way as represented in the specification of the instant specification.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S 3,965,555 teaches a method of forming joints on one side of a pipe.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL A. WARTALOWICZ whose telephone number is (571)272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Wartalowicz
May 11, 2008

/Steven Bos/
Primary Examiner
A.U. 1793